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IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

**On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit**

BRIEF OF THE DALLAS-FORT WORTH INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* URGING AFFIRMANCE

INTEREST OF THE *AMICUS CURIAE*[*]

Formed in the mid-1950s, the Dallas-Fort Worth Intellectual Property Law Association is a regional association of persons concerned with the patent, trademark, copyright, trade secret, and other laws protecting intellectual property rights. The Association, which was formerly known as the Dallas-Fort Worth Patent Association, is a member of the National Council of Intellectual Property Law Associations.

The Association's approximately 100 members, mostly attorneys, regularly represent clients in patent litigation, advise clients in patent and licensing matters, and represent clients in

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[*] The parties' letters of consent have been filed with the Clerk pursuant to Rule 37.3.

administrative proceedings before the United States Patent and Trademark Office. In patent litigation, the Association's attorney members represent individuals, universities, and small and large businesses in trial and appellate proceedings. The members' clients are split roughly evenly between patent owners and accused infringers.

Neither the Association nor any of its members has any direct interest in any of the parties or in which side prevails in this lawsuit, except to the extent that the outcome affects the administration of the patent laws. A principal object of the Association is to aid in the institution of improvements in the patent laws and court procedures for administering those laws. To promote that objective, this *amicus curiae* brief sets forth the Association's observations regarding the likely practical effects of the ruling below on the conduct of patent litigation and regarding the need to allow the Federal Circuit to develop a consistent body of law concerning the respective roles of judge and jury in that litigation.

SUMMARY OF ARGUMENT

The historical record on the jury's role in interpreting patent claims is conflicting and ambiguous. *Amicus* takes no position on how those historical conflicts should be resolved, but notes that under any historically supportable resolution of the jury-trial issue in this case the ultimate result below should be affirmed.

By itself, the decision below does not significantly curtail the role of juries in patent cases. Instead, both its effect on the role of juries and its attainment of more consistent and predictable decisions in patent cases depend on how the Federal Circuit decides related issues. Since the decision below, that court has already resolved major related issues in a manner that preserves the factfinding role of juries while promoting uniform, certain, and predictable resolutions of issues of patent claim scope.

Congress established the Federal Circuit for the express purpose of promoting development of a uniform body of substantive and procedural law to govern patent issues. In view

of the cloudy historical record and the influence ongoing decisions of related issues will have on the decision's practical effects, this Court should uphold the Federal Circuit's ruling that disputes of patent claim interpretation present only legal issues for judges to decide.

ARGUMENT

I. *Amicus* Takes No Position as to the Conflicting Historical Record on the Seventh Amendment Right to Jury Trial of the Meaning of Patent Claims; Regardless of How that Conflict Is Resolved, the Result Below Should Be Affirmed.

The jurisprudence of the Seventh Amendment, guided by the amendment's language, turns in significant part on the historical inquiry: Would the issue in dispute have been triable by jury under the common law of England in 1791? As the varied opinions below and briefs in this Court demonstrate, that inquiry is clouded by an ambiguous and conflicting record, devoid of any contemporaneous[1] decision clearly assigning the issue to judge or jury.

Amicus takes no position as to the proper resolution of this historical inquiry, other than to note that it should be based on a precise definition of the issue as to which a jury-trial right is asserted. The decision below concerns only disputes as to the meaning of utility patent *claims*, an American innovation to patent

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[1] Subsequent decisions assigning an issue to the jury are not directly relevant, since they may reflect a jury right, not preserved by the Seventh Amendment, that arose after 1791. Moreover, subsequent decisions do not consistently treat patent claim interpretation as a jury issue. *See, e.g., Coupe v. Royer*, 155 U.S. 565, 579 (1895) (judge "defines the patented invention as indicated by the language of the claims; the jury judge whether the invention so defined covers the art or article employed by the defendant") (quoting 3 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS 378 (4th ed. 1890)).

law begun in 1822.[2] Genuine disputes as to the meaning of a patent's *specification*, which may arise if an accused infringer contends the patent is invalid for lack of a disclosure adequately teaching those skilled in the art to practice the invention, will continue to be decided by juries. Moreover, the decision below leaves to the jury disputes as to the scope of non-utility patents;[3] that scope is governed by the prior practice of factually assessing similarities between the accused infringement and the invention as disclosed in the specification. In short, the decision below narrowly focusses on disputes over the scope of the legal decrees of exclusivity embodied in utility patent claims.

It should also be noted that, even under the analysis previously followed by the Federal Circuit, this case would not have presented a claim interpretation issue for the jury. The dispute turns on the meaning of "inventory," a common, ordinary word, not a technical term. Under the prior analysis, conclusory

[2] Earlier patents contained only a "specification," which described and showed the invention in technical terms and enabled its practice by those skilled in the art. The scope of a patent was determined by comparing the invention as described and shown with the accused infringement. Our present patent laws, in contrast, require an applicant to submit claims, which are carefully scrutinized and sometimes revised by the Patent and Trademark Office, thereby legally defining the patent's coverage. 35 U.S.C. § 112, first paragraph (1988). For accounts of the historical development of patent claims, see generally 2 DONALD S. CHISUM, PATENTS § 8.02, at 8-5 to -13 (1995); Karl B. Lutz, *Evolution of the Claims of U.S. Patents* (pts. 1-3), 20 J. PAT. OFF. SOC'Y 134, 377, 457 (1938); *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1530-31 (Fed. Cir. 1995) (Newman, J., concurring), *petition for cert. filed*, No. 95-728 (Nov. 6, 1995); and *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560-61 (Fed. Cir. 1991).

[3] In addition to utility patents on inventions, 35 U.S.C. § 101 (1988), the patent laws provide for issuance of plant patents and design patents, 35 U.S.C. §§ 161, 171 (1988). Plant and design patents have claims only in formal terms. 37 C.F.R. §§ 1.153(a), 1.164 (1995).

opinions on the meaning of an ordinary word raised no genuine jury issue.[4] Thus, in all events, the result below should be affirmed.

II. The Practical Effects of the Decision Below Depend on the Manner in Which the Federal Circuit Resolves Related Issues.

The briefs filed in support of petitioner, as well as concurring and dissenting opinions below, suggest the holding that claim interpretation presents only legal issues is tantamount to denying outright the right to a jury in patent infringement cases. As even dissenting Judge Newman has previously noted, however, many patent infringement cases turn on issues other than claim interpretation.[5] Indeed, the principal factual issue underlying the infringement determination--whether the accused activity or product satisfies the limitations of the properly construed claim language--is unaffected by the decision below. Particularly from a trial lawyer's perspective, patent infringement cases often present many jury issues that are not foreclosed by the decision below, including the factual inquiries underlying patent-law doctrines of conception, reduction to practice, diligence, prior invention, and obviousness. This reality has been confirmed by several experiences of members of *amicus* since the decision below.

In their briefs, petitioners and supporting *amici* question the soundness of the various practical and policy considerations cited by the Federal Circuit in support of its ruling. They attack the Federal Circuit's conclusion that allowing judges to decide the

[4] *E.g., Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579-80 (Fed. Cir. 1989); *Howes v. Medical Components, Inc.*, 814 F.2d 638, 643-44 (Fed. Cir. 1987).

[5] *Senmed, Inc. v. Richard-Allan Medical Industries, Inc.*, 888 F.2d 815, 823 (Fed. Cir. 1989) (Newman, J., dissenting) ("Many patent infringement determinations do not require a preliminary 'claim interpretation' . . . .").

meaning of patent claims will promote uniformity and predictability in patent matters.

In *amicus*'s view, these attacks are premature. Both the frequency of jury trials under the decision below and the benefits of that decision will ultimately depend not simply on the decision itself, but on how the Federal Circuit proceeds in fashioning a coherent body of law applying the decision. Inherent in any language, for example, is a limit beyond which definitions cannot meaningfully elaborate. In applying the decision below, the Federal Circuit must determine where interpretation of a claim (by a judge) ends and application of that interpretation (by the jury) begins. Appropriate demarcation of this boundary can preserve the vitality of juries while promoting the benefits sought by the decision below.

The Federal Circuit can similarly promote these twin goals by setting appropriate procedures for the conduct of "*Markman* hearings"--proceedings conducted early in patent cases by which trial judges hear detailed arguments, review the patent and its prosecution history, and resolve disputes of claim interpretation. Based on their experience in the past few months, members of *amicus* believe that with appropriate safeguards these hearings can greatly enhance the fairness and efficiency of patent litigation while preserving the role of juries.

To implement the decision below, the Federal Circuit must also establish rules governing related issues. By establishing these rules appropriately, that court can ensure that the factfinding role of the jury is preserved fully while still promoting uniform and predictable resolution of disputes over patent scope. The Federal Circuit has already begun that effort.

One example is the Federal Circuit's *en banc* decision in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995), *petition for cert. filed*, No. 95-728 (Nov. 6, 1995). Patents are infringed not only by products and activities literally embraced by their claims, but also under the "doctrine of equivalents" by substantially similar products and activities. In

resolving conflicts among Federal Circuit panels on several aspects of that doctrine, *Hilton Davis* reaffirmed that the determination of whether sufficient similarity exists is one for the jury to make as a matter of fact. 62 F.3d at 1522.

Another illustration of the continued vitality of juries in patent matters arises in cases involving the scope of one form of patent claim--the so-called "means plus function" claim--that under the Patent Code[6] is determined by comparing the accused product or activity with the invention's description in the patent specification. The decision below reserved decision on whether this comparison is for judge or jury. 52 F.3d at 977 n.8. In *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 1575 (Fed. Cir. 1995), the Federal Circuit appears to have determined it is an issue of fact for the jury. These subsequent decisions demonstrate that, contrary to petitioners' arguments, the decision below does not end the substantial role of juries in patent trials.

III. This Court Should Promote the Congressional Goals Underlying Creation of the Federal Circuit by Affirming and Allowing that Court to Establish a Uniform Body of Procedures for Patent Cases.

Congress created the Federal Circuit expressly to promote "nationwide uniformity in patent law."[7] In view of the increasing importance to the nation's economy of uniform and reliable results in patent matters,[8] Congress concluded that a single court should handle all patent appeals, so that a consistent and uniform body of patent law can be developed and maintained.[9] Recognizing that this Court's broad jurisdiction and limited resources preclude it from reviewing patent cases with the

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[6] 35 U.S.C. § 112, sixth paragraph (1988).

[7] H.R. Rep. No. 312, 97th Cong., 1st Sess. 20 (1981); *see* Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25.

[8] H.R. Rep. No. 312, 97th Cong., 1st Sess. 22-23 (1981).

[9] *Id.* at 20, 23.

frequency necessary to perform that role,[10] Congress created the Federal Circuit to "fill this void."[11]

As the only Court of Appeals having its jurisdiction defined exclusively by subject matter rather than geography, the Federal Circuit employs a special expertise and carries out a special mission. On questions such as that here presented, where concrete historical tests are inconclusive and the analysis instead depends mainly on sound policies for, and the practicalities of, patent litigation, the Federal Circuit's judgment should not lightly be disturbed.[12]

Here, the question is whether disputes over the meaning of utility patent claims present issues of law or fact. The Federal Circuit concluded they were legal issues, reasoning that patent claims, which are governmental decrees of exclusivity, should be treated like statutes.[13] With that conclusion, the Federal Circuit

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[10] In earlier times, a significant part of this Court's resources was devoted to patent cases. For example, the Court conducted twelve days of argument on the *Telephone Cases,* 126 U.S. 1 (1888); an entire volume of *United States Reports* is devoted to the report of that case.

[11] H.R. Rep. No. 312, 97th Cong., 1st Sess. 22 (1981).

[12] *See Dennison Manufacturing Co. v. Panduit Corp.,* 475 U.S. 809, 811 (1986) (remanding to obtain "the Federal Circuit's informed opinion on the complex issue of the degree to which the obviousness determination is one of fact"); *see also United States v. Fausto,* 484 U.S. 439, 464 n.11 (1988) (Stevens, J., dissenting) ("Because its jurisdiction is confined to a defined range of subjects, the Federal Circuit brings to the cases before it an unusual expertise that should not lightly be disregarded."); *cf. Cardinal Chemical Co. v. Morton International, Inc.,* 113 S. Ct. 1967, 1979-80 (1993) (Scalia, J., concurring in part) (noting experience of Federal Circuit judges in their specialized patent jurisdiction).

[13] Although resolving those issues sometimes requires weighing conflicting opinions, such weighing is commonplace in deciding legal issues, as demonstrated by the historical inquiry facing the Court in this case. The propriety of weighing conflicting evidence

began the task of establishing a coherent body of procedures designed to promote uniform, certain, and predictable results while preserving the role of the jury.[14] This Court should allow the Federal Circuit to use its special expertise to complete that task.

CONCLUSION

The decision of the Federal Circuit that disputes over the meaning of utility patent claims present only issues of law should be affirmed.

Respectfully submitted,

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in resolving disputed issues of law is recognized, for example, in FED. R. CRIM. P. 26.1 and FED. R. CIV. P. 44.1, which direct trial courts to determine foreign law issues by considering all relevant materials and sources, and provide that the ruling shall be treated as one of law.

[14] *See generally* Rochelle C. Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts,* 64 N.Y.U. L. REV. 1, 5-23, 74-75 (1989) (describing Federal Circuit's progress in establishing "accurate, precise, and coherent" body of law for patent cases and advocating that Federal Circuit be given broad authority to continue).